

REMARKS

Reconsideration and withdrawal of the rejections of this application and consideration and entry of this paper are respectfully requested in view of the herein remarks, which place the application in condition for allowance.

I. STATUS OF CLAIMS AND FORMAL MATTERS

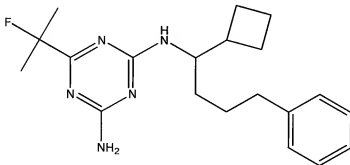
The applicants thank the Examiner for meeting with the applicants' representative during the interview of 21 May 2007. With the entry of this amendment claims 3, 6-9 and 12-21 are now pending in this application.

New claim 19 corresponds to previous claim 11 except that formulae (VI)-(IX) have been deleted and the disclaimer has been deleted as it is no longer necessary in light of the claim amendment. New claim 20, corresponds to the combination of herbicides discussed during the 21 May 2007 interview. New claim 21 corresponds to previous claim 4 except that formulae (A4)-(A7) have been deleted. No new matter has been added.

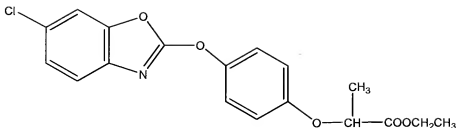
It is submitted that the claims, herewith and as originally presented, are patentably distinct over the prior art cited in the Office Action, and that these claims were in full compliance with the requirements of 35 U.S.C. § 112. The amendments of the claims, as presented herein, are not made for purposes of patentability within the meaning of 35 U.S.C. §§§§ 101, 102, 103 or 112. Rather, these amendments and additions are made simply for clarification and to round out the scope of protection to which Applicants are entitled.

II. TRAVERSAL TO RESTRICTION REQUIREMENT

However, the applicants do request that a new Office Action on the merits be mailed which repeats the restriction requirement from the parent application and accepts the applicants' election of the following species below:



(A1) 4-amino-6-(1-fluoro-1-methylethyl)-2-(3-phenyl-1-cyclobutylamino)-1,3,5-triazine



Fenoxaprop-P-ethyl (part of B1.3.3).

This election is made WITH TRAVERSE.

The traversal is on the grounds that a restriction/election of species requires that "If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." *See MPEP 803.*

There has been no holding that extending the search beyond the combination of (A1) and (B1.3.3) would constitute an undue burden on the office or if so, at what point the search would constitute an undue burden.

III. THE 35 U.S.C. 112, 1ST PARAGRAPH REJECTION ("Written Description") HAS BEEN OVERCOME

Claims 2-4, 6-9 and 11-18 were rejected as allegedly failing to comply with the written description requirement, i.e. the applicants were alleged to have had no possession of the invention of the subject matter as claimed at the time of filing the application.

The initial burden for establishing lack of possession of the invention resides with the Office.¹ However, despite 4½ pages of boilerplate text regarding 1st paragraph rejections, no explanation was given as to why the present case fails to meet the written description requirement.

Moreover, any explanation for establishing lack of possession must overcome a significant evidentiary hurdle as it has previously been held that "To satisfy the description requirement of section 112, first paragraph, an application must contain sufficient disclosure, expressly or inherently, to make it clear to one skilled in the art that the appellant was in

¹ MPEP 2163, section I. A. ("There is a *strong presumption that an adequate written description of the claimed invention is present when the application is filed.* In *re Wertheim*, 541 F.2d 257, 263, 191 USPQ 90, 97 (CCPA 1976) ("we are of the opinion that the *PTO has the initial burden of presenting evidence or reasons* why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims.") - emphasis added by applicants.

possession of the subject matter claimed...'[A] statement of the appellant's invention [in his specification] which is as broad as appellant's broadest claims' *is sufficient to meet this requirement.*" see *In re Eickmeyer*, 202 USPQ 655, 662 (CCPA 1979).

Given this low threshold for complying with the written description requirement, the Office Action has not met the initial burden for establishing lack of possession and as such the rejection may be withdrawn.

IV. THE 35 U.S.C. 112, 1st PARAGRAPH REJECTION ("Enablement") HAS BEEN OVERCOME

Claims 2-4, 6-9 and 11-18 were rejected as allegedly failing to comply with the enablement requirement for the full scope of the invention claimed. As with the written description requirement, there is little to no explanation for the holding of lack of enablement beyond the boilerplate language.² While the applicants disagree with the original rejection, in order to advance prosecution, the claims have been amended to refer to (A1) and (A2) as component (A) and the component (B) has been amended to include those compounds agreed to have synergistic effects.

The applicants reserve the right to pursue the scope of the originally filed claims in a divisional or continuation application.

IV. THE 35 U.S.C. 103 REJECTION HAS BEEN OVERCOME

Claims 2-4, 6-9 and 11-13 were rejected as being obvious over the combined teachings of Giencke et al. (U.S. Patent 6,239,071 - "Giencke"), Zindel et al. (WO 98/34925 - "Zindel"); Hirata et al. (A: EP 467 204; B: EP 469 406; C: EP 471 221; D: EP 471 284), Takematsu (Abstract of JP 04095003); Hirata et al. (A: Abstract of JP 7267804; B: Abstract of JP 7267805).

The applicants maintain their response from the response filed on 14 March 2007 as the only rebuttal in the previous Office Action was merely a statement that applicants' arguments were unpersuasive with no explanation as to why this was believed to be so.

When, as here, the applicants present a reasonable rebuttal, whether buttressed by experiment, prior art references, or argument, *the entire merits of the matter are to be reweighed.* In *re Hedges*, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986). The

applicants' arguments should not have been judged for their knockdown ability with respect to the rejection.³

² Determining enablement is a question of law based on underlying factual findings (see MPEP 2164.01, page 2100-174 and *In re Vaeck*, 947 F.2d 488, 495, 20 USPQ2d 1438, 1444 (Fed. Cir. 1991); *Atlas Powder Co. v. E.I. di Pont de Nemours & Co.*, 750 F.2d 1569, 1576, 224 USPQ 409, 413 (Fed Cir. 1984)).

³ "When prima facie obviousness is established and evidence is submitted in rebuttal, the decision-maker **must start over**. . . . **An earlier decision should not**, as it was here, be considered as set in concrete, and applicant's rebuttal evidence then **be evaluated only on its knockdown ability**. Analytical fixation on an earlier decision can tend to provide that decision with an undeservedly broadened umbrella effect. Prima facie obviousness is a legal conclusion, not a fact. Facts established by rebuttal evidence must be evaluated along with the facts on which the earlier conclusion was reached, **not against the conclusion itself**. . . . [A] final finding of obviousness may of course be reached, but such finding will rest upon evaluation of all facts in evidence, uninfluenced by any earlier conclusion reached by an earlier board upon a different record." *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

CONCLUSION

In view of the remarks and amendments herewith, the application is believed to be in condition for allowance. Favorable reconsideration of the application and prompt issuance of a Notice of Allowance are earnestly solicited. The undersigned looks forward to hearing favorably from the Examiner at an early date, and, the Examiner is invited to telephonically contact the undersigned to advance prosecution. The Commission is authorized to charge any fee occasioned by this paper, or credit any overpayment of such fees, to Deposit Account No. 50-0320.

Respectfully submitted,
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